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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/930,422	08/15/2001	Peter Ar-Fu Lam	DISPMT1	1550

7590  
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20104 Wayne Ave.  
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EXAMINER
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BUCHANAN, CHRISTOPHER R

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3627

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12/22/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/930,422	<b>Applicant(s)</b> LAM, PETER AR-FU	
	<b>Examiner</b> CHRISTOPHER R. BUCHANAN	<b>Art Unit</b> 3627	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-34 and 37-52 is/are pending in the application.
- 4a) Of the above claim(s) 1-5, 19-34, 37-39, 41-48, 50 and 51 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6, 7, 9-18, 40, 49 and 52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 8 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 6, 7, 9-18, 40, 49, and 52 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, a 35 U.S.C § 101 process must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the particular machine to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively

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recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps are not tied to a particular machine and do not perform a transformation. Thus, the claims are non-statutory.

The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101. Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 6, 7, 9-18, 40, 49, and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spackova et al. (US 4,539,585) in view of Aisaka et al. (US 4,417,401).

Regarding claim 40, Spackova discloses a method of processing a body profile (BP) code describing the physical dimensions of a human body to facilitate garment shopping, the method including the steps of;

(1) specifying the positions of the body to be measured (indicia (74) shown in Fig. 3 specify the position) for defining m different physical dimensional parameters of said human body (the indicia segments (72) and coded indicia (74) are used to define various physical parameters of a subject wearing a form fitting garment, col. 4 line 1+, see Fig. 3),

(2) measuring in length units (x-y-z axes are for dimensions of length, col. 3 line 55, fundamental units of measurement are mass, *length*, and time) a physical dimension of said body to produce m values for each of said m defined parameters (the orientation of each segment (72) and indicia (74) are computer identified (i.e., measured and stored, col. 4 line 7+) and used to provide a body location on which items of apparel should be worn (col. 4 line 18+), wherein orientation includes rotation and *position* (col. 3 line 54+, position is measured in length units), this constitutes measuring the body and producing values for the parameters); and

(3) processing said m values to produce a multiple digits BP code for representing said m values (computer and image processor process orientation information, col. 3 line 12-15, the form fitting garment (71) contains a plurality of coded segments (72) which are used *in toto* to form a composite image of the garment and, therefore, of the subject's body since the garment is form fitting (col. 4 line 1+), the stored data for the composite image would result in a multi-digit code that represents the particular features (m values) for that body).

The method of Spackova differs from the claimed method in that the body profile code is not explicitly shown to be a compressed code (claim 40) or to include a primary

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compressed n1 digits code and a supplemental n2 digits code for representing said m values, wherein said n2 digits code further comprises a n3 digits code (claims 6, 7, 9-18 and 49) and wherein the code can be decompressed to reproduce said m values (claim 52).

Aisaka discloses a device for measuring garments and the body of a garment wearer (col. 1 line 60, device rates the body and physique of garment wearer) and teaches using a multiple digit compressed body profile code (No. 5, M, XL, etc., col. 1 line 7-20) to represent the measurements of the garment wearer's body. The various measurements of the body (waist, chest, height, etc.) are "compressed" into a single code (e.g., M or size 42) that represents the overall body profile.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Spackova so that the body profile code is a compressed code, as taught by Aisaka, to make garment shopping easier for individuals that know their body profile code. The examiner further gives official notice that the feature of a compressed body profile code is well-known and commonly used in the art. Codes for body sizes, such as "Large" or "dress size 4" or "jacket size 42", have been in widespread use for many years.

Regarding claims 6, 7, 9-18 and 49, it would have been obvious to one of ordinary skill in the art at the time of the invention that the different data strings (n1 and n2 codes) could be used for a variety of applications (garment fitting, data manipulation, etc.) all of which are well-known. The particular application selected for the n1 and n2 data strings (e.g., size chart for fitting purposes, enhance resolution, physical

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dimensional parameter, non-dimensional related information related to said human-body, out of range information of a parameter, etc.) would be a matter of design choice since it has not been shown to serve any particular purpose or solve any stated problem. Regarding claim 52, since the m values are being compressed to produce a BP code by some process, it would be a matter of logic that a similar process could be used to decompress the code to provide the original input quantities. This process is merely arrives at the starting point of having m values, thus does not provide any useful result. The examiner further gives official notice that data compression, decompression and manipulation are well-known in the art. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine these features with the teachings of the prior art since it merely provides predictable results.

### ***Allowable Subject Matter***

6. Claim 8 has allowable subject matter over the prior art of record.

### ***Response to Arguments***

7. Applicant's arguments filed October 30 and November 6, 2009 have been fully considered but they are not persuasive. Applicant argues that the prior art references used in the rejection do not disclose all of the recited features of the claimed invention. In particular, applicant argues that the Spackova reference does not disclose the recited features of independent claim 40 and requests that the examiner precisely compare the recited claim limitations with the disclosed features of the prior art used in the rejection.

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Applicant points out that the claims of the instant invention are directed to a process and that any interpretation of the disclosure of Spackova must come from “normal operation” of the invention. Applicant also argues that the Aisaka reference does not show measuring a human body or a body profile code composed of multiple numerical digits, but merely makes measurements for a garment. Applicant also requests evidence supporting the rejection of claims 6, 7, 9-18, and 49. Furthermore, applicant has submitted an affidavit which apparently argues that the invention of Spackova is not functional. Applicant also inquires as to the level of skill of a person having ordinary skill in the art. Lastly, applicant traverses the rejection made under 35 U.S.C. 101 and argues that the rejection is improper.

The examiner disagrees and stands by the rejection. The examiner notes that the rejection above clearly equates the disclosed features of the prior art with the recited features of the claimed invention, points out the location in the prior art where these features can be found, and describes the examiner’s interpretation of how these features are equated. Applicant apparently wants a one-to-one, verbatim matching between the language recited in the instant claims and the teachings of the prior art. However, this is not entirely possible due to differences in terminology, the nature of the rejection (which combines teachings from multiple references in this case), and actual differences between the inventions themselves. No amount of explanation or comparison can overcome a difference of opinion held between the examiner and applicant regarding the interpretation of what is being claimed and what is disclosed by the prior art. Furthermore, Spackova describes the design and operation of a system



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that enables users to preview articles of clothing without actually trying on the article (see col. 3 line 5+, col. 4 line 1+), which is analogous art related to the instant invention. In the examiner's interpretation, this description discloses the design of the system and the normal operation of the system showing the claimed "process steps" of specifying, measuring, and processing during "normal operation", as set forth in the rejection above. Normal operation is taken to be the functioning of the system as described in the specification of the reference. For example, in Fig. 3 the coded indicia (74) are specifying the positions of the body to be measured. A similar argument can be applied to the other recited features. Regarding the Aisaka reference, as stated in the rejection above, this reference is only being used to show a code (related to garments and the *bodies* that wear them) that is a compressed code. The examiner notes it is stated (col. 1 line 60) that the device can rate the body form and physique of a garment wearer, thus it can measure a human body. Aisaka gives examples of standard compressed codes (No. 9, etc., col. 1 line 7-11) which are all single digits. However, these are merely examples, and one skilled in the art could logically assume that there is also a size 10, a size 11, and so on, which are multiple digit numerical compressed codes. Regarding the rejection of claims 6, 7, 9-18, and 49, applicant's traversal of the rejection and request for supporting evidence does not constitute a proper response to the rejection made under design choice. A proper response to rejections made using official notice or design choice require the applicant to submit reasoned arguments that explain how the rejection is invalid and describe the novelty of, purpose of, and problems solved by the invention along with evidence supporting these arguments. The

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examiner has considered applicant's declaration, but has found the arguments to be unconvincing. Applicant claims to have had problems using a TV camera to perform measurements of body parameters due to slow frame rate and low frequency response of the TV line signal and has provided related evidence in appendix A. In the examiner's view, these unsupported statements, even if accurate, do not prove the invention of Spackova to be non-functional. More detailed information along with supporting evidence proving the invention of Spackova does not work would be required to do this. It is unclear how the graphs shown in appendix A relate to the matters at hand and no explanation is provided. Regarding the issue of one of ordinary skill in the art, one of ordinary skill in the art is taken to be a hypothetical person that works in the field and that has both pieces of prior art available for consideration. Finally, regarding the rejection under 35 U.S.C. 101, the Supreme Court precedent and Federal Circuit decisions require that the claimed process 1) be tied to a particular machine (such as a computer system for performing calculations) or 2) transform subject matter to a different state or thing. The claims of the instant invention do not satisfy either of these conditions.

### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTOPHER R. BUCHANAN whose telephone number is (571)272-8134. The examiner can normally be reached on Mon.-Fri. 9:00am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. R. B./  
Examiner, Art Unit 3627

/F. Ryan Zeender/

Supervisory Patent Examiner, Art Unit 3627